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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,369	08/24/2001	Lou Chauvin	83304AF-P	3908

7590 01/26/2007  
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EXAMINER
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POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/939,369	<b>Applicant(s)</b> CHAUVIN ET AL.	
	<b>Examiner</b> Melvin H. Pollack	<b>Art Unit</b> 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> .       |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 November 2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1-22 were cancelled in favor of new claims 23-39. New art has been found in response to the new claims.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 23-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 is drawn towards "A method.... Comprising providing application software on a *medium* that is executable on a personal computer for enabling the personal computer...." This is a non-statutory embodiment, and the specification does not provide further limiting definitions regarding medium, i.e. as a recordable disk as opposed to a data carrier wave.

### ***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23-28, 30-35, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart et al. (US 2003/0208691) in view of Bouve et al. (2001/0021930).

8. For claims 23, 39, Smart teaches a method (abstract) of linking (Paras. 1-11) a user of a digital camera (Fig. 2, #102) to a retail fulfillment service provider (Fig. 2, #104) selected from a plurality of different retail fulfillment service providers (Fig. 2, #106), comprising:

- a. Providing application software on a medium that is executable on a personal computer (Para. 42) for enabling the personal computer to communicate over a communication network with the plurality of different retail fulfillment service providers (Para. 44);
- b. Providing a services directory that includes entries for a plurality of different retail fulfillment service providers (Para. 53);
- c. Automatically displaying on the personal computer a list of one or more of said plurality of different retail fulfillment service providers based on a criterion (Paras. 115-120);
- d. Selecting one of said plurality of different retail fulfillment service providers from said list (Paras. 77, 78, 116, 170; Table 1); and

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- e. Communicating a print order from the personal computer over the communication network to the selected retail fulfillment service provider (Fig. 15, #508; Paras. 127 and 170).
9. Smart does not expressly disclose receiving a location of a user, or displaying a list based on location. Bouve teaches a method and system (abstract) of providing a commonly updated services directory (Paras. 1-37 and 95-97), wherein said directory contains services information (Paras. 38-42), such that a user may select an item of interest and discover nearby retail providers (Paras. 60 – 63), the list being automatically displayed (Paras. 53-59), and locations are clearly selectable (Para. 92). At the time the invention was made, one of ordinary skill in the art would have added the location information in order to provide recommendations of store areas (Para. 10).
10. For claim 24, Smart teaches displaying the list based on a additional criteria (Paras. 115-120; table 1).
11. For claim 25, Smart teaches displaying the list based on one of the following: Brand; Cost of service; Specific Product characteristics; Delivery time; Delivery method; Delivery reach; Specific provider characteristics; Access time; or Ability to ship to specific location (Paras. 95-101).
12. For claim 26, Smart teaches displaying the list is based on a criteria directly associated with a digital image (Paras. 95-101; table 1; assoc. in terms of photo quality).
13. For claim 27, Smart teaches automatically providing the list through the use of a locator service (Para. 53).

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14. For claim 28, Smart teaches that displaying the list is based on a dynamic criteria (Paras. 53 and 95-101; criterion changes based on client's needs on resolution of the print job and supported image formats).
15. For claim 30, Smart teaches displaying a list that is set for a predetermined period of time (Table 1; print job's expected time of completion).
16. For claim 31, Smart teaches displaying the list is based on a work flow capacity of the provider (Paras. 95-101; certain printers can only do certain jobs, affecting work flow).
17. For claim 32, Smart teaches automatically adjusting the dynamic criteria based on predetermined criterion (Para. 116; Table 1; criteria predetermined based on user's sample selection).
18. For claim 33, Smart teaches obtaining a subset of retail service providers from the list based on a second criterion (Fig. 20, #2012 and #2014; Para. 127).
19. For claim 34, Smart teaches obtaining and displaying the subset based on one of the following: least expensive or closest (Para. 97 and Table 1; I/O matching).
20. For claim 35, Smart teaches positioning the one or more of said plurality of retail fulfillment service providers on a display screen based on the criteria (Para. 170).
21. For claim 38, Smart teaches displaying the list on a kiosk that is used to access the service provider (Paras. 42-47; Fig. 1, #1702; Fig. 21, #2100).
22. Claims 29, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart and Bouve as applied to claim 28 above, and further in view of I'Anson et al. (2002/0059196).

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23. For claim 29, Smart and Bouve do not expressly disclose displaying the list is based on price. I'Anson teaches a method and system (abstract) of providing lists (Paras. 1-55 and 95-108) based on price and location (Paras. 68-94). At the time the invention was made, one of ordinary skill in the art would have combined the inventions to improve the method of comparison shopping (Para. 91).

24. For claim 36, Smart and Bouve do not expressly disclose displaying the one or more of said plurality of retail fulfillment service providers based on the amount paid by the one or more of said plurality of retail fulfillment service providers to be in said service directory. I'Anson teaches this limitation (Paras. 68-94). At the time the invention was made, one of ordinary skill in the art would have combined the inventions to improve the method of comparison shopping (Para. 91).

25. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smart and Bouve as applied to claim 23 above, and further in view of Okuda et al. (2002/0001099).

26. For claim 37, Smart and Bouve do not expressly disclose displaying the one or more of said plurality of retail fulfillment service providers based on a contract. Okuda teaches a method and system (abstract) of displaying remote printing services (Paras. 1-41) wherein listings include contract information (Paras. 42-94). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to improve user settlement convenience (Para. 8).

### ***Conclusion***

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27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard further references on remote printing, geographical shopping, and work flow methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin H Pollack  
Examiner  
Art Unit 2145

MHP  
19 January 2007

*Melvin H. Pollack*

